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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,338	12/30/2003	Alex M. Greenberg	5421-3	8136
27799	7590	12/30/2005	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			TALBOT, MICHAEL	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,338

Applicant(s)

GREENBERG, ALEX M.

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-25, 29, 30 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-25, 29, 30 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first and second sleeve" recited in newly amended claim 19, the "resilient elastomer" recited in claim 21, the "plurality of alignment pieces" recited in claim 24 and the "counter sink bore" recited in new claim 37 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. As noted in the original Office Action dated 31 May 2005, the disclosure is objected to because of the following informalities:

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Refer to page 5, line 2, the word "threadeldy" has been misspelled and should be changed to --threadedly--.

Refer to page 8, line 18, the character reference "inner threaded area 34" should be changed to --inner threaded area 36--.

These informalities were not addressed by Applicant's amendment dated 02 September 2005. Appropriate correction is required.

Claim Objections

3. Claim 19 is objected to because of the following informalities:

Claim 19, page 9 of Applicant's Arguments, lines 15 and 16, the claimed amended text "a shoulder, mounted on one of said second sleeve and said centering member, for limiting a depth of penetration of said drill bit into said surface" should be revised to change the preposition "and" to --or-- so as to indicate --a shoulder, mounted on one of said second sleeve or said centering member, for limiting a depth of penetration of said drill bit into said surface--. This limits the shoulder to be mounted on either of the centering member or the second sleeve as detailed in Applicant's Arguments, page 13, lines 19-22, and not both as currently claimed with the use of the word "and".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-24 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement (as noted in the original Office Action dated 31 May 2005). The claim(s) contains subject matter which was not described in the specification in

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such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is still unclear how the claimed limitations of newly amended claim 19, specifically the limitation of a first and a second sleeve, are shown in Figure 6 and/or disclosed in the specification on pages 13 and 14, paragraphs [0024] through [0027]. Briefly, newly amended claim 19 recites limitations to the structure of a first and second sleeve but the specification and Figure 6 only disclose a single outer sleeve 98. It is unclear as to how the two sleeve structure will be integrated into Figure 6 when the specification only breaths life into a single outer sleeve structure. The claim language must be rewritten to properly and clearly claim the limitations and/or dependencies of claims 19-24 and 37.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3,8,11 and 13-18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Bashlow et al. '353 in view of Erickson et al. '427. Bashlow et al. '353 shows in Figures 1-4 a stop (14) for a drill bit (12) where the drill bit has a cutting groove, an elongate body rotatable about an axis, a tip at one end of body, an opposing second end (10) for coupling to a drill and a engagement region disposed between the tip and second end. Bashlow et al. '353 further shows the stop comprising a first sleeve (22,56) being rotatably mounted to drill bit (through connection at 16 and 20) having a first thread (18) and a second thread (38) with a different thread pitch (col. 4, lines 6-28). Bashlow et al. '353 further shows the stop comprising a second sleeve (42) being threadably coupled (44) to second thread of first sleeve and defining a

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shoulder (54) for limiting a depth of penetration of drill bit into an object (W). Both first and second sleeves have an axis of rotation which is co-incident with axis of drill bit and the first sleeve includes an outwardly projection (56) having a knurled surface (col. 3, lines 57 and 58) providing means for gripping. Bashlow et al. '353 further shows the second thread (38) of the first sleeve being disposed on the interior of first sleeve and thread (44) of the second sleeve being disposed on the exterior of second sleeve forming a locking mechanism (34,38,44) between the first and second sleeves.

Bashlow et al. '353 lacks the presence of the first and second sleeves having fine and coarse indicia for monitoring the drill bit distance. Erickson et al. '427 shows in Figures 1-12 an adjustment device (10) having a fine adjustment sleeve (16) with fine adjustment indicia (46,92) threaded to a coarse adjustment sleeve (18) with coarse adjustment indicia (45,45',142) for monitoring the drill bit (18) distance (col. 2, lines 32-43, col. 3, lines 27-40, col. 4, lines 10-21, col. 5, lines 22-27 and col. 6, line 64 through col. 7, line 19) and a set screw (76) for locking the sleeves together (col. 4, lines 22-37). In view of this teaching of Erickson et al. '427, it would have been obvious to one of ordinary skill in the art to modify the adjustment device of Bashlow et al. '353 by providing fine and coarse adjustment indicia (markings or color coding) on the adjustment sleeves to more accurately and positively determine the depth/penetration of the drill bit through improved visual indications, thus improving overall efficiency and repeatability of the operation and to incorporate a locking screw to affix the desired adjustment in place.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashlow et al. '353 in view of Erickson et al. '427, further in view of Robertson '436. Bashlow et al. '353 in view of Erickson et al. '427 lack the engagement region being both a cutting groove and also an engagement threading on the drill bit. Robertson '436 shows in Figure 5 the stop (26) being directly threaded to the drill bit (28) using the cutting grooves (col. 5, line 65 through col. 6, line

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8). In view of this teaching of Robertson '436, it would have been obvious to one of ordinary skill in the art to replace the outwardly directed flange (20) and external threads (18) of the chuck (16) of Bashlow et al. '353 in view of Erickson et al. '427 with a direct connection of the stop to the drill bit shown by Robertson '436 to eliminate the need for a specialized chuck.

8. Claims 9,10,12,25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashlow et al. '353 in view of Erickson et al. '427, further in view of Zech et al. '178. Bashlow et al. '353 in view of Erickson et al. '427 lack the presence of the indicia being disposed on the drill bit and engagement threading on the drill bit. Zech et al. '178 shows in Figure 1 a drill bit (20) having indicia (31) disposed on the exterior surface and engagement threading (24) to sleeve (10). In view of this teaching of Zech et al. '178, it would have been obvious to one of ordinary skill in the art to modify the adjustment device of Bashlow et al. '353 in view of Erickson et al. '427 to include the indicia directly on the drill bit to further to further enhance the accuracy of the depth/penetration of the drill bit through additional visual indications, thus improving overall efficiency and repeatability of the operation and to include a direct connection of the stop/sleeve to the drill bit shown by Zech et al. '178 to eliminate the need for a specialized chuck.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashlow et al. '353 in view of Erickson et al. '427 in view of Zech et al. '178, further in view of Robertson '436. Bashlow et al. '353 in view of Erickson et al. '427 in view of Zech et al. '178 lack the engagement region being both a cutting groove and also an engagement threading on the drill bit. Robertson '436 shows in Figure 5 the stop (26) being directly threaded to the drill bit (28) using the cutting grooves (col. 5, line 65 through col. 6, line 8). In view of this teaching of Robertson '436, it would have been obvious to one of ordinary skill in the art to replace the outwardly directed flange (20) and external threads (18) of the chuck (16) of Bashlow et al. '353

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in view of Erickson et al. '427 in view of Zech et al. '178 with a direct connection of the stop to the drill bit shown by Robertson '436 to eliminate the need for a specialized chuck.

10. Claims 1-3,8,11 and 13-16 are rejected under 35 U.S.C. 103(b) as being unpatentable over Mawhinney '971. Mawhinney '971 shows in Figure 1 a stop (20) for a drill bit (41) where the drill bit has a cutting groove, an elongate body rotatable about an axis, a tip at one end of body, an opposing second end for coupling to a drill and a engagement region disposed between the tip and second end. Mawhinney '971 further shows the stop comprising a first sleeve (54,42,52) being rotatably mounted to drill bit (through connection at 31 and 32) having a first thread (45) and a second thread (threaded area between 42 and 70) with a different thread pitch (seen from details of Figure). Mawhinney '971 further shows the stop comprising a second sleeve (66,62,60) being threadably coupled (threaded area between 42 and 70) to second thread of first sleeve and defining a shoulder (col. 3, lines 43-47) for limiting a depth of penetration of drill bit into an object. Both first and second sleeves have an axis of rotation which is co-incident with axis of drill bit. Mawhinney '971 further shows indicia (col. 3, lines 50-52) for both fine and coarse adjustment representing the depth of penetration. Mawhinney '971 further shows the second thread (threaded area between 42 and 70) of the first sleeve being disposed on the exterior of first sleeve and thread (threaded area between 42 and 70) of the second sleeve being disposed on the interior of second sleeve.

Mawhinney '971 lacks the presence of the first and second sleeves having fine and coarse indicia for monitoring the drill bit distance. Erickson et al. '427 shows in Figures 1-12 an adjustment device (10) having a fine adjustment sleeve (16) with fine adjustment indicia (46,92) threaded to a coarse adjustment sleeve (18) with coarse adjustment indicia (45,45',142) for monitoring the drill bit (18) distance (col. 2, lines 32-43, col. 3, lines 27-40, col. 4, lines 10-21, col. 5, lines 22-27 and col. 6, line 64 through col. 7, line 19). In view of this teaching of Erickson

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et al. '427, it would have been obvious to one of ordinary skill in the art to modify the adjustment device of Mawhinney '971 by providing fine and coarse adjustment indicia (markings or color coding) on the adjustment sleeves to more accurately and positively determine the depth/penetration of the drill bit through improved visual indications, thus improving overall efficiency and repeatability of the operation.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mawhinney '971 in view of Erickson et al. '427, further in view of Robertson '436. Mawhinney '971 in view of Erickson et al. '427 lack the engagement region being both a cutting groove and also an engagement threading on the drill bit. Robertson '436 shows in Figure 5 the stop (26) being directly threaded to the drill bit (28) using the cutting grooves (col. 5, line 65 through col. 6, line 8). In view of this teaching of Robertson '436, it would have been obvious to one of ordinary skill in the art to replace the outwardly directed flange (20) and external threads (18) of the chuck (16) of Mawhinney '971 in view of Erickson et al. '427 with a direct connection of the stop to the drill bit shown by Robertson '436 to eliminate the need for a specialized chuck.

12. Claims 9,10,12,25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mawhinney '971 in view of Erickson et al. '427, further in view of Zech et al. '178. Mawhinney '971 in view of Erickson et al. '427 lack the presence of the indicia being disposed on the drill bit and engagement threading on the drill bit. Zech et al. '178 shows in Figure 1 a drill bit (20) having indicia (31) disposed on the exterior surface and engagement threading (24) to sleeve (10). In view of this teaching of Zech et al. '178, it would have been obvious to one of ordinary skill in the art to modify the adjustment device of Mawhinney '971 in view of Erickson et al. '427 to include the indicia directly on the drill bit to further to further enhance the accuracy of the depth/penetration of the drill bit through additional visual indications, thus improving overall

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efficiency and repeatability of the operation and to include a direct connection of the stop/sleeve to the drill bit shown by Zech et al. '178 to eliminate the need for a specialized chuck.

13. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mawhinney '971 in view of Erickson et al. '427 in view of Zech et al. '178, further in view of Robertson '436. Mawhinney '971 in view of Erickson et al. '427 in view of Zech et al. '178 lack the engagement region being both a cutting groove and also an engagement threading on the drill bit. Robertson '436 shows in Figure 5 the stop (26) being directly threaded to the drill bit (28) using the cutting grooves (col. 5, line 65 through col. 6, line 8). In view of this teaching of Robertson '436, it would have been obvious to one of ordinary skill in the art to replace the outwardly directed flange (20) and external threads (18) of the chuck (16) of Mawhinney '971 in view of Erickson et al. '427 in view of Zech et al. '178 with a direct connection of the stop to the drill bit shown by Robertson '436 to eliminate the need for a specialized chuck.

Allowable Subject Matter

14. Claims 19-24 and 37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

15. The indicated allowability of claims 7,9,11,12,18 and 28 is withdrawn in view of the newly discovered reference(s) to Erickson et al. '427 and Zech et al. '178. Rejections based on the newly cited reference(s) are described above.

Response to Arguments

16. Applicant's arguments with respect to claims 1-4,8-25,29,30 and 37 have been considered but are moot in view of the new ground(s) of rejection.

17. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's


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office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



MWT
Examiner
23 December 2005



BOYER D. ASHLEY
PRIMARY EXAMINER